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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

SHERRER, C

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 03/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/693,499

Applicant(s)
Ono et al

Examiner
Curtis E. Sherrer

Group Art Unit
1761



☒ Responsive to communication(s) filed on Jun 20, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 2, and 7-28 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, and 7-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 7-12, and 20-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have amended their claims to include the phrase "which has not been previously extracted" and no specification basis could be found.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 7-12, and 19-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The scope of the phrase "essential oil components," as found in claims 1-2, is unknown. See page 15, lines 32-35 for possible phrasing that would define said phrase's scope.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haeffner et al. (U.S. Pat. No. 5,011,594)(hereinafter Haeffner).

8. Haeffner teaches that cited in the previous Office Actions. Regarding claim 2, while Haeffner broadly teaches the treatment of various substances, he does not specifically refer to non-extracted hops. In the Background of the Invention portion, it is stated that air dried hops have previously been extracted using super critical CO₂ (col. 1, lines 31-35). Haeffner's disclosure is an attempt to improve upon the prior art. It would have been obvious to those of ordinary skill in the art to treat non-extracted hops using the methods of Haeffner because Haeffner teaches that the prior art, when using non-extracted hops, is not as efficient.

9. Claims 1, 2 and 7-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over ANH (B.E. Pat. No. 1897012) in view of Krasd Food (S.U. Pat. No. 1601112) for the reasons set forth in the last Office Action.

Response to Arguments

10. Applicant's arguments filed 06/29/009 have been fully considered but they are not persuasive.

11. Applicants first argue that the Examiner's interpretation of the term hops is unduly broad because portions of the specification do not refer to treating hop extracts. The specification does not specifically exclude treating hop extracts and therefore the term is interpreted in light of how those of ordinary skill in the art would interpret the term. The examiner has presented evidence that the term reasonably reads on hop extracts.

12. Second Applicants argue that the 102 rejection is improper because Haeffner et al only treat hop extracts and the claims as now amended state the hops must not have been previously extracted. It is noted that Haeffner et al admit that it is well known the prior art to treat whole hops using super critical carbon dioxide (see col. 1, lines 31-34). In light of Applicants' amendment, Claim 2 is now considered obvious.

13. Applicants then argue that Haeffner does not suggest the method of Claim 1 because it does not suggest that the ratio of oils to acids is increased by a factor of 2, but rather the

purpose is to provide a greater yield. This by itself does not exclude the changing of the relative amounts of hop components in the final products. While Haeffner is silent on the amounts of oils, because the method taught is the same as claimed, the Haeffner and claimed products are the same. The Office does not have the facilities for examining and comparing Applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed are functionally different than those taught by the prior art and to establish patentable differences. See *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 1977); *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1923 (BPAI).

14. Further, it would be obvious to those of ordinary skill in the art to modify, i.e., optimize, the amounts of hop constituents because they are result effective variables, i.e., the more oil, the more aroma, the more acid, the more bitterness.

15. Applicants also argue that the obviousness rejection based on ANH in view of Krasd Food is not proper because they do not teach or motivate those in the art to produce an "essential oil-rich hop extract." It appears that applicants view this phrase narrowly. The phrase broadly indicates that the extract is richer in oil than normal, rather than it has mostly oil relative to other constituents. It is also noted that no specific amounts of oil are claimed.

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As such, as long as the extract has more oil than would normally be found in the extract then it is an "essential oil-rich hop extract."

Conclusion

16. No claim is

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847.

The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The fax phone number for this Group is (703)-305-3602.

18. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



Curtis E. Sherrer
Primary Examiner
March 16, 2001